

REMARKS

Claims 1-37 are pending in this application. Claims 16-35 have been withdrawn from consideration due the Restriction Requirement. Claims 1 and 36 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to assist the Examiner to expedite compact prosecution of the instant application.

Claims 1-15, 36 and 37 have been rejected under 35 U.S.C. §102(b) as being anticipated by EP 0838812 for reasons stated on page 2 of the Office Action (Paper No.20060130). Specifically, the Examiner asserts that,

"The reference shows an optical disk reading apparatus having a light source with a wavelength larger than 659 nm 11, an objective lens having annular rings 216, the focused light beam having a NA that is less than 0.72 μ m for reading a **first disk fig 3** and a second numerical aperture which is larger than 0.8 μ m for reading a **second disk fig 2(a)**, a beam splitter for changing the beam path 12, and a photo detection means 30."

However, the Examiner's assertion is incomplete. Independent claims 1 and 36 define additional features that have **not** been addressed by the Examiner and that are **not** disclosed or suggested by EP 0838812. As a result, Applicants traverse the rejection and respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

Base claim 1 defines a compatible optical pickup device comprising, *inter alia*:

"an objective lens having a near axis area, a ring type annular lens area, and a far axis area with respect to an apex, said objective lens being arranged: to focus the light emitted from said light source to form a first light spot when the first optical disk, which is relatively thin, is received, and a second light spot when the second optical disk, which is relatively thick, is received, and the first light spot having an FWHM (full width at half maximum) less than or equal to 0.72 μ m with respect to the first optical disk, and the second light spot having an FWHM greater than or equal to 0.8 μ m with respect to the second optical disk"

Likewise, base claim 36 defines a compatible optical pickup device comprising, *inter alia*:

"an objective lens to receive the light and is designed in relation to the wavelength to form:
a first light spot having a FWHM (full width at half maximum) that is less than or equal to 0.72 μ m when the first optical disk is received, and
a second light spot having a FWHM that is greater than or equal to

0.8 μm when the second optical disk is received."

In contrast to Applicants' base claims 1 and 36, EP 0838812 discloses an optical pickup device, as shown in FIG. 1, in which a different type of objective lens 16 is used, as shown in FIG. 2A. Such an objective lens 16 is provided with a refracting surface S1 on the light source side that is composed of plural (three) divided surfaces Sd1 - Sd3 which are concentric with an optical axis. As described on page 6 of EP 0838812, steps (i.e., step depths) are provided on boundaries between the divided surfaces Sd1 - Sd3 such that a different light flux (i.e., first, second and third light fluxes) which passes through a different divided surface is used to reproduce information recorded in either a first optical disk or a second optical disk. This way side lobe jitters can be minimized.

In an alternative embodiment shown in FIG. 6 of EP 0838812, an optical pickup device having two light sources are used, including a first semiconductor laser 111 (wavelength of 610 - 670 nm) representing a first light source for reproducing a first optical disk, and a second semiconductor laser 112 (wavelength of 740 - 870 nm). However, the same concept of light fluxes are applied as described.

There is no disclosure from EP 0838812 nor is there any teaching or suggestion of Applicants' claimed "objective lens having a near axis area, a ring type annular lens area, and a far axis area with respect to an apex... to form a first light spot having a FWHM (full width at half maximum) that is less than or equal to 0.72 μm when the first optical disk is received, and a second light spot having a FWHM that is greater than or equal to 0.8 μm when the second optical disk is received" as generally defined in claims 1 and 36.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). In addition, the prior art reference must be enabling. Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc.,

793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, EP 0838812 fails to disclose and suggest key features of Applicants' base claims 1 and 36. Therefore, Applicants respectfully request that the rejection of claims 1-15, 36 and 37 be withdrawn.

Claims 2-15 and 37 which depend from base claims 1 and 36, are deemed patentable from base claims 1 and 36 if their base claims 1 and 36 are patentable. Hartness Int'l, Inc., v. Simplicatic Eng'g Co., 891 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987); In re Abele, 684 F.2d 909, 214 USPQ 682, 689 (CCPA 1982) *see also* In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Even assuming *arguendo* that independent claims 1 and 36 are not patentable under 35 U.S.C. §102, which Applicants do not believe, claims 2-15 and 37 are separately patentable from parent claims 1 and 36 for reasons presented herein below.

For example, dependent claims 3, 6, and 7 further define that Applicants' claimed "objective lens has an effective numerical aperture greater than or equal to 0.63 with respect to the first optical disk, and an effective numerical aperture less than or equal to 0.53 with respect to the second optical disk."

In contrast to Applicants' claims 3, 6 and 7, EP 0838812 utilizes a completely different set of NAs depending upon the wavelength of the light source, see TABLE 8, for example, in which NA for DVD and CD reproduction is approximately 0.42 - 0.46; TABLE 11 in which NA for DVD and CD reproduction is approximately 0.32-0.40; TABLE 14 and TABLE 15 in which NA for DVD and CD reproduction is approximately 0.41-0.45; TABLE 18 in which the NA for DVD and CD reproduction is approximately 0.45-0.52; TABLE 22, TABLE 23, TABLE 26 and TABLE 27 in which the NA for DVD and CD reproduction is approximately 0.44-0.53; TABLE 30 and TABLE 34 in which the NA for DVD and CD reproduction is approximately 0.38-0.45.

Claims 8, 9, 10 and 11 further define that the ring-type annular lens area of said objective lens is optimized to the second optical disk so that,

when the first optical disk is to be reproduced/recorded, the light that forms the first light spot passes through the near axis area and the far axis area and is focused on an information recording surface of the first optical disk, and
when the second optical disk is to be reproduced/recorded, the light that forms the second light spot passes through the near axis area and the annular lens area and is focused on the information recording surface of the second optical disk.

There is no disclosure or suggestion anywhere from EP 0838812 of these features of Applicants' claims 8, 9, 10 and 11.

In view of these reasons, Applicants respectfully request that the rejection of Applicants' dependent claims 2-15 and 37 be withdrawn.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext. 232.

INTERVIEW:

In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. attorney at the local Washington, D.C. telephone number (202) 216-9505 ext. 232 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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